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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,794	11/12/2003	Kelly W. Adams	074901.0103	7188
5073	7590	03/09/2005	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			DOAN, ROBYN KIEU	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/706,794

Applicant(s)

ADAMS, KELLY W.

Examiner

Robyn Doan

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7-9, 12 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Clemente Marco (6378529).

With regard to claims 1, Clemente Marco discloses an apparatus for cosmetically coloring skin (figs 1, 3) comprising a base, an elongated handle (1) extending from the base in a first direction and a plurality of cosmetic skin coloring elements (2) configured to couple to the base and extend therefrom in a second direction substantially perpendicular to the first direction (fig. 1), each cosmetic skin coloring element having a cosmetic skin coloring agent (8) disposing proximate a free end thereof. In regard to claim 9, the apparatus adapted to cosmetically color a desired area of skin which is an area of a person's scalp (col. 3, lines 48-54). In regard to claims 7-8, Clemente Marco further discloses a configuration of a cosmetic skin coloring element being selectively changeable (col. 3, lines 30-34) and each of the cosmetic skin coloring element comprising a protrusion (figs. 5-7) at an end distal the free end, the protrusion

configured to engage a groove formed in the base (fig. 2). In regard to claims 12, 18-21, the above apparatus is inherently capable to perform the claimed method steps.

Claims 1-3, 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Murray (5056480).

With regard to claim 1, Murray discloses an apparatus for cosmetically coloring skin (fig. 1) comprising a base (34), an elongated handle (36) extending from the base in a first direction and a plurality of cosmetic skin coloring elements (44, col. 1, line 50) configured to couple to the base and extend therefrom in a second direction substantially perpendicular to the first direction (fig. 1), each cosmetic skin coloring element having a cosmetic skin coloring agent (cosmetic liquid flows through tip 54) disposing proximate a free end thereof. In regard to claims 2-3, Murray also discloses the base being generally flat (fig. 1) with first and second sides (at 54, 52), each cosmetic skin coloring element having an intermediate portion (portion between 54, 52, fig. 1) between two free ends (54, 52) and configured to couple to and extend from both the first and second sides. In regard to claims 12-14, the above apparatus is inherently capable to perform the claimed method steps.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3732

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clemente Marco.

With regard to claims 5-6 and 16-17, Clemente Marco discloses an apparatus for cosmetically coloring skin comprising all the claimed limitations in claims 1 and 12 as discussed above except for each cosmetic skin coloring element having a cosmetic skin coloring agent of a different color. It would have been an obvious matter of design choice to employ a variety of colors to the cosmetic skin coloring agents, since such modification would involved a routine skill in the art.

Claims 4, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clemente Marco in view of Fitjer (EP327803A2).

With regard to claims 4, 10 and 15, Clemente Marco discloses an apparatus for cosmetically coloring skin comprising all the claimed limitations in claims 1 and 12 as discussed above except for the cosmetic skin coloring elements comprising eyebrow pencils. Fitjer discloses a cosmetic device (figs. 1-9) comprising a cosmetic applicator (abstract) being an eyebrow pencil (it is noted that a core must be present in the pencil, when one refers to a pencil and also since the reference refers the pencil is used for cosmetic, it is inherently used for eyebrow). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the pencil as taught by Fitjer into the apparatus of Clemento Marco for the cosmetic use purpose.

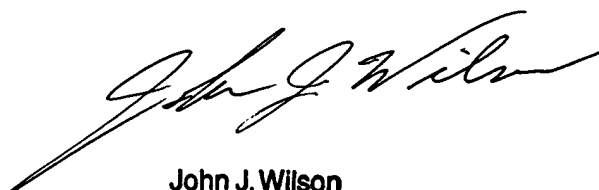
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 9:30-7:00; alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robyn Doan  
Examiner  
March 4, 2005



John J. Wilson  
Primary Examiner